



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,140	04/29/2005	Shinichi Yamazaki	03500.017696.	4169

5514 7590 11/02/2007  
FITZPATRICK CELLA HARPER & SCINTO  
30 ROCKEFELLER PLAZA  
NEW YORK, NY 10112

EXAMINER
----------

HSU, AMY R

ART UNIT	PAPER NUMBER
----------	--------------

2622

MAIL DATE	DELIVERY MODE
-----------	---------------

11/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/533,140

Applicant(s)

YAMAZAKI ET AL.

Examiner

Amy Hsu

Art Unit

2622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 32-46 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 32-38 and 41-46 is/are rejected.
- 7) ☒ Claim(s) 39 and 40 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/20/07, 9/12/06, 6/24/05</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

The USPTO "Interim Guidelines for Examination of Patent Applications for Patent Subject Matter Eligibility" (Official Gazette notice of 22 November 2005), Annex IV, reads as follows:

Descriptive material can be characterized as either "functional descriptive material" or "nonfunctional descriptive material." In this context, "functional descriptive material" consists of data structures and computer programs, which impart functionality when employed as a computer component. (The definition of "data structure" is "a physical or logical relationship among data elements, designed to support specific data manipulation functions." The New IEEE Standard Dictionary of Electrical and Electronics Terms 308 (5th ed. 1993).) "Nonfunctional descriptive material" includes but is not limited to music, literary works and a compilation or mere arrangement of data.

When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized. Compare *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994) (claim to data structure stored on a computer readable medium that increases computer efficiency held statutory) and *Warmerdam*, 33 F.3d at 1360-61, 31 USPQ2d at 1759 (claim to computer having a specific data structure stored in memory held statutory product-by-process claim) with *Warmerdam*, 33 F.3d at 1361, 31 USPQ2d at 1760 (claim to a data structure per se held nonstatutory).

In contrast, a claimed computer-readable medium encoded with a computer program is a computer element which defines structural and functional interrelationships between the computer program and the rest of the computer which permit the computer program's functionality to be realized, and is thus statutory. See *Lowry*, 32 F.3d at 1583-84, 32 USPQ2d at 1035.

Claims 45-46 are rejected under 35 U. S. C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 45-46 define a program for

controlling a communication apparatus and an image storage apparatus. However, the claim does not define a computer readable medium or memory and is thus non-statutory for that reason.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 32-38,41-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanaka et al. (US 7265780) in view of Sato et al. (US 7265779).

Regarding Claim 32, Tanaka teaches a communication apparatus (*Fig. 5*), comprising: a recognizing device for recognizing an attribute of positional information that is added to image data stored in a communicating party (*images stored by the communicating party, "electronic camera" in Col 8 Lines 21-25, are transmitted to the communication device, which includes position information as described in Col 8 Lines 69-66. The content of Fig. 9 are sent to and recognized by the communication device including the position information as depicted*); a searching device for searching the image data stored in the communicating party based on the recognition made by the recognizing device (*Col 16 Lines 54-55 describes the user can find and therefore select a desired image where the images are classified by parameters*); a selecting device for selecting a desired one of a plurality of attributes recognized by the

*recognizing device (Col 16 Lines 43-58 teaches the camera, which is the communicating party, classifies images for each parameter representing the property of the image, and the user can select in accordance with a specific application).*

Tanaka fails to teach the device judging whether the positional information of the attribute selected is utilizable in the communication apparatus.

Sato teaches a camera which transmits and receives information from a cell phone. In Fig. 10, Sato teaches that positional information is obtained and the judges if the information is appropriate to use for the application, which in this case is to determine whether a user's place is present within the positional information obtained. Although Sato teaches the communication apparatus obtains the positional information, instead of receiving it from the stored image in the camera, the teaching of Sato where positional information is judged for usability of a specific application is extracted and how the communication apparatus first gained the positional information is immaterial to the teaching that it is judged for usability.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Tanaka's communication apparatus which recognizes a location from information attached to an image received from a communicating party and judges, with that of Sato, to realize a device which also judges whether the obtained positional information is usable an application. One of ordinary skill in the art would have combined the teachings because Tanaka's device recognizes the positional information, yet the point of obtaining this information is for some specific application, for example for using positional information for classifying

images by location shot. To obtain positional information for a specific purpose would require knowing if the information is even usable for that specific application. One of ordinary skill in the art would realize the efficiency of determining whether the obtained position information is even usable before proceeding to the application of the information such as classifying images based on this information.

Regarding Claim 33, Tanaka teaches a communication apparatus according to claim 32, but fails to teach the judging device. Sato teaches obtaining positional information, and based on that information makes a judgment as addressed with Claim 32. Sato does not teach the communicating device, which makes the judgment, receives the information from the communicating device. However, Sato is used to teach judging positional information for usability. Tanaka teaches the communicating device obtained positional information from an image data stored in the communicating party as addressed with Claim 32.

It would have been obvious to combine for the same rationale as Claim 32.

Regarding Claim 34, Tanaka teaches a communication apparatus according to claim 32, further comprising a display device (*Fig. 5*) for displaying the attribute of the positional information recognized by the recognizing device (*Col 7 Lines 20-27 teaches the attached information with the image is displayed and Col 8 Lines 59-66 teach that the attached information includes attributes of positional information*).

Regarding Claim 35, Tanaka teaches a communication apparatus according to claim 32, further comprising an inquiry device for making an inquiry to the communicating party as to what attribute of a search condition is added to the image data stored in the communicating party, wherein the recognizing device makes the recognition based on a result of the inquiry made by the inquiry device. Col 16 Lines 43-58 teaches that the communication apparatus receives, which means it inquired or requested the received information from the communicating party, an image file of a desired parameter according to information of the directory produced by the communicating party.

Regarding Claim 36, Tanaka teaches a communication apparatus according to claim 35, wherein the inquiry device makes the inquiry each time the communication apparatus connects with the communicating party in order to search the image data stored in the communicating party. Fig. 12 shows that the procedure after the connection is complete, S106, is requesting, or inquiring, for the file list, S108, then the communicating device receives and displays the file list in S114.

Regarding Claim 37, Tanaka teaches a communication apparatus and teaches that a mode can be set from the communicating party side in which the inquiry device does not make the inquiry even when the communication apparatus connects with the communicating party in order to search the image data stored in the communicating party. Col 5 starting from Line 62 teaches a power conservation mode set from the

Art Unit: 2622

communicating party side, where it can still be connected to the communication apparatus but does not make the inquiry. Tanaka does not teach the mode is set from the communication apparatus. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Tanaka by setting the power save mode from the communication apparatus side because power save mode is well known in electronic transiting devices. Specifically in this case, one of ordinary skill in the art would have realized the modification because the communicating apparatus is the side where the user gives input and having the power save mode taught by Tanaka for the communicating party side would have been obvious to implement on the side involving the user to compensate for lack of activity on the user end.

Regarding Claim 38, Tanaka teaches a communication apparatus according to claim 35, further comprising a setting device for setting a mode in which the inquiry device makes the inquiry when the communication apparatus connects with the communicating party, independently of the search of the image data stored in the communicating party. Tanaka teaches the standard procedure is to inquire the communication party for the file list after connection as seen in Fig. 12 but does not teach a mode to be set to do this standard procedure. The search occurs after the inquiry as seen in Fig. 12 so it is independent. In view of the rationale addressing Claim 37, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the teaching of Tanaka to have a mode for the standard procedure



Art Unit: 2622

since there it would have been obvious to have a mode for not inquiring the communicating device as addressed with Claim 37. It would have been obvious because having a power save mode where inquiry does not occur, would also require a means for switching back to a mode where inquire does occur in order to give the user a choice to compensate for lack of activity by the user.

Regarding Claim 41, Tanaka teaches an image storage apparatus (*Fig. 3 reference number 56 and 54, the recording medium and recording medium interface*), comprising: an informing device for informing a communicating party of an attribute of positional information related to stored image data (*from the communicating device via the transmitting and receiving device, reference number 60*); a searching device for searching the image data in accordance with a request from the communicating party (*Col 16 Lines 43-58 teaches the storage apparatus, or the image information transmitting end, classifies plurality of images for each parameter, where the parameter is chosen by the communicating device. Figs. 16-18 show the directories to be searched in accordance with what is selected by the communicating device*); but fails to teach a judging device.

Sato teaches after positional information is acquired it can be judged for usability of a specific application. Motivation to combine is addressed with Claim 32.

Regarding Claim 42, Tanaka teaches image storage apparatus according to claim 41, wherein the informing device informs the communicating party of the attribute

in accordance with a request from the communicating party (*Col 16 Lines 43-58 teaches the informing device and the communicating party, or the image information transmitting end, acquires the attribute from the communication device, and Fig. 12 teaches S136, the communicating party produces a property file and requests the communication device to display a property, in S140*).

Claim 43 is a method claim, which enables the apparatus of Claim 32 and is therefore rejected with the same rationale.

Claim 44 is a method claim, which enables the apparatus of Claim 41 and is therefore rejected with the same rationale.

Claims 45-46 are programs for controlling the communication apparatus of Claim 32 and the image storage apparatus of Claim 41 and are therefore rejected with the same rationale.

#### ***Allowable Subject Matter***

4. Claims 39-40 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims because the prior art fails to teach the communication apparatus of Claim 32 further comprising the searching device

Art Unit: 2622

converting the positional information to a given search condition in accordance with the attribute of the positional information.

### ***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Squilla et al. (US 6396537) teaches a photographing system that is capable of interactive communication with a user.

Nakamura (US 6337951) teaches a data sender which sends photo data relating to a designated place.

Allen et al. (US 5768633) teaches a photographic and data transmission system utilizing a wireless communication system and a camera for capturing an image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy Hsu whose telephone number is 571-270-3012.

The examiner can normally be reached on M-F 8am-5pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on 571-272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Amy Hsu  
Examiner  
Art Unit 2622

ARH 10/29/07



LIN YE  
SUPERVISORY PATENT EXAMINER